

REMARKS/ARGUMENTS

Applicants note that the Examiner objects to claims 45, 46, 48, 50 and 52 as being dependent on a rejected base claim. In view of the response submitted herein Applicants reserve the right to amend the objected-to claims to overcome the rejection.

Response to rejections under 35 U.S.C. § 103:

The Examiner has rejected claim 44, 47, 49, 51 and 53-56 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 6,110,914.

Applicants respectfully traverse the Examiner's rejection and take the position that the Examiner has not established a *prima facie* case of obviousness.

The following are quotations from three sections of the Manual of Patent Examining Procedure ("MPEP") which form the basis for the response set forth herein to the obviousness rejection in the Office action:

Section 2141, **Basic Considerations which Apply to Obviousness Rejections**, states, in part,

"When applying 35 U.S.C. § 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention and
- (D) reasonable expectation of success is the standard with which obviousness is determined.

Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143, n.5, 229 USPQ 182, 187, n.5 (Fed. Cir. 1986)."

Section 2142, **Legal Concept of *Prima Facie* Obviousness**, states in part, "The Examiner bears the burden of factually supporting any *prima facie* conclusion of obviousness."

Section 2143, **Basic Requirements of a *Prima Facie* Case of Obviousness**, states, in part,

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

The Examiner has rejected claims 44, 47, 49, 51 and 53-56 under 35 U.S.C. § 103(a) 6,110,914 (Phillips *et al.*, hereafter '914") and asserts that '914, "generically disclose the instant compounds in the '914 patent in column 1, lines 45-67 and column 2, lines 1-27.

In *Determination of the scope and content of the prior art (MPEP § 2141.01)* (at page 3 of the Office action), the Examiner makes certain assertions.

The Examiner asserts, "Phillips *et al.*, generically disclose the instant compounds in the '914 patent." Applicants respectfully point out that they have already successfully rebutted the Examiner's assertion that '914 anticipates compounds of the instant application, so '914 cannot, and does not, disclose any genus that includes compounds of the instant application or any individual compound of the instant application. Thus, the Examiner's further assertion that "Phillips *et al.*, teach the method of use of compounds and compositions of the instant compounds" is without basis since such compounds are not disclosed in '914.

The Examiner further asserts (on page 4, lines 3-5 of the Office action), "RN 220100-57-2 generically teaches the instant claims when, in the instant claims R is hydrogen, and C1-4alkyl; and when R1 is -(CH₂)_nAr, Ar is phenyl and n is 0 to 3. Again, Applicants respectfully point out that they have already successfully rebutted the Examiner's assertion that '914 anticipates compounds of the instant application, so '914 cannot, and does not, disclose any genus that

includes compounds of the instant application or any individual compound of the instant application.

Therefore, Applicants fail to understand and accordingly dispute the Examiner's interpretation of the disclosure of '914, and since that interpretation underlies the present rejection under 35 U.S.C. § 103(a), respectfully request that the Examiner withdraw the corresponding rejections.

In *Ascertainment of the difference between the prior art and the claims (MPEP § 2141.02)* (at page 4 of the Office action) the Examiner concedes that "RN 220100-73-2 differs from the instant claims" and that "RN 220100-57-2 differs from the instant compounds." The Examiner further states "in RN 220100-57-2 the -NH(CH₂)Ph group is in the 5-position while in the instant claims the -NH(CH₂)Ph group is in the 5 or the 6 position. RN 220100-57-2 suggests that the -NH(CH₂)Ph group can be in the 5 or the 6 position."

Applicants concede that RN 220100-57-2 discloses a -NH(CH₂)Ph group in the 5-position, but that is all, nothing in RN 220100-57-2 suggests an -NH(CH₂)Ph group at a 6 position. Accordingly, Applicants fail to find basis for the Examiner's assertion and request that the Examiner either provide factual basis (MPEP 2142) for the assertion or withdraw the rejection based thereon.

In *Finding of prima facie obviousness - rationale and motivation (MPEP § 2142-2143)* (at page 4 of the Office action), the Examiner asserts that "nothing unobvious is seen in substituting the known claimed isomer for the structurally similar isomer as taught by Phillips et al., since such structurally related compounds suggest one another and would be expected to share common properties absent a showing of unexpected results."

Applicants fail to understand why the Examiner believes that one isomer suggests another. While it may be obvious to try another isomer, it may also be obvious to try all sorts of chemical variations. However, respectfully point out that this is not the test for obviousness.

Applicants do not have to show "unobviousness." Rather, obviousness must be shown by the Examiner (MPEP 2143) by (1) identifying some suggestion or motivation, either in '914 itself or in the knowledge generally available to those of ordinary skill in the art, to modify '914 or

combine reference teachings; (2) that there must be a reasonable expectation of success; and (3) by showing that '914 teaches or suggests all claim limitations. Applicants can find no suggestion or motivation in '914 to modify the genus or compounds disclosed therein to make the genus or compounds of the instant application; they can find nothing in '914 that would make an experimenter think there was a reasonable expectation of success; and, finally, they can find no teaching or suggestion in '914 of all the claim limitations.

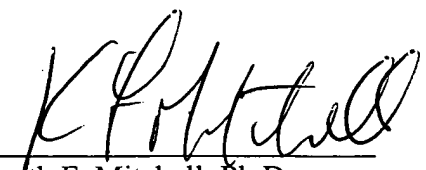
In view of the foregoing, Applicants fail to understand how the disclosure of '914 makes obvious the compounds of the instant application. Applicants can find nothing in '914 that suggests or that would motivate one to make the compounds of the instant invention. As articulated above, Applicants read '914 to disclose compounds different from those of the instant invention and find no suggestion to modify the compounds disclosed therein in ways that would lead to the instant compounds. Accordingly, Applicants invite the Examiner to reconsider the rejection for obviousness and to withdraw this rejection.

Conclusion:

In view of the arguments presented herein, Applicants respectfully invite the Examiner to withdraw all rejections and submit that the claims of this application are in condition for allowance. Applicants solicit prompt issuance of a Notice of Allowability and Notice of Issue Fee Due.

Respectfully submitted,

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